

REMARKS

Status of the claims:

With the above amendment, claim 1 has been amended and claim 2 has been canceled, and claims 11-13 have been added. Claims 1 and 3-13 are pending and ready for further action on the merits. No new matter has been added by way of the above amendment. Support for the amendment to claim 1 comes from page 3, lines 30-32 (lines 9-11 from the bottom) and from original claim 2. Claims 11-12 have support at page 3, lines 20-26. Claim 13 has support at page 5, lines 4-12. Reconsideration is respectfully requested in light of the following remarks.

Specification Objections

The Examiner has objected to minor informalities in the specification. Upon a review of the specification, the Applicant asserts that the specification is free of informalities. However, if the Examiner becomes aware of any informalities, the Examiner is invited to disclose them, and at that time, Applicant will correct them.

Rejections under 35 USC §112, second paragraph

Claims 1-10 have been rejected under 35 USC §112, second paragraph as being indefinite. The Examiner asserts that the phrases "characterized in", "the outermost layer" and "the opposite side" are indefinite.

Claim 1 has been amended so that "characterized in that" has been changed to "wherein". Further, claim 1 has been amended so that the phrase "the outermost layer" has been amended to recite either "a first outermost layer" or "a second outermost layer" and "the opposite side" has been changed to "an opposite side".

Moreover, the Examiner asserts that it is unknown what is the structural relationship between the "outermost layer" on the opposite side of the support with the outermost layer on the same side of the support. The goal of the instant invention is to form an image-forming material that is less adhesive. Thus, in furtherance of this goal, the binder on the outermost layer opposite the support side differs from that on the outermost layer on the same side. Accordingly, it is believed that with the above explanation and amendments, the relationship between the "outermost layer" on the opposite side of the support with the outermost layer on the same side of the support is neither vague nor indefinite.

The Examiner also asserts that the phrase "have a common monomer composition to a degree less than 75 wt%" in claim 2 is indefinite. Claim 2 has been canceled so this rejection is moot. In any event, the monomer composition in the binder on the same side as the image forming material has less than 75% wt commonality with the binder on the opposite side of the support. It is believed that with the above amendments and explanations, all of the 35 USC §112, second paragraph rejections have been obviated. Withdrawal of the rejections is respectfully requested.

Rejections under 35 USC §102

Claim 1 has been rejected under 35 USC §102(a) as being anticipated by Okamura '629 (EP 0 903 629 A1). The Examiner asserts that Okamura '629 discloses a protective layer on one side of the support that differs from the protective layer on the image forming side of the support. Claim 2 has been incorporated into claim 1. Because claim 2 was not rejected, it is believed that the rejection has been obviated. Withdrawal of the rejections is respectfully requested.

Claims 1-10 have been rejected under 35 USC §102(b) as being anticipated by Defieuw '467 (EP 0 810 467 A1). The Examiner asserts that Defieuw '467 discloses the materials of the instant invention with a binder in the backing layer and the protective

layer having different compositions. This rejection is traversed for the following reasons.

The Examiner's attention is drawn to the backside layer composition described at page 15, lines 18-33 and the protective layer composition described at page 16, lines 1-24 in Defieuw '467. These compositions do not fall within the scope of instantly amended claim 1. Accordingly, Defieuw '467 can not anticipate the instant invention because Defieuw '467 fails to disclose the elements of the instant invention. Withdrawal of the rejection is respectfully requested.

Claim 1-8 and 10 have been rejected under 35 USC §102(e) as being anticipated by Melpolder '754 (US Patent No. 6,287,754). The Examiner asserts that Melpolder '754 discloses the materials of the instant invention with a binder in the backing layer and the protective layer having different compositions. This rejection is traversed for the following reasons.

The Examiner's attention is drawn to the backing layer composition described at column 12, lines 16-20 and the protective layer composition described at column 12, lines 42-62 in Melpolder '754. These compositions do not fall within the scope of instantly amended claim 1. In particular, Melpolder '754 fails to disclose a polymer latex as claimed in the instantly claimed 1. Accordingly, Melpolder '754 can not anticipate the instant

Appl. No.: 09/640,803
invention because Melpolder '754 fails to disclose the elements of
the instant invention. Withdrawal of the rejection is
respectfully requested.

Rejections under 35 USC §103

Claim 1-10 have been rejected under 35 USC §103(a) as being
unpatentable over Melpolder '754 in view of Defieuw '467. This
rejection is traversed for the following reasons.

Present Invention

The present invention relates to a thermally processed image
forming material having a first side and a second side. The
first side has an image forming layer and an outermost layer
containing a binder. The second side has an outermost layer
containing a binder, which is different from the binder of the
outermost layer on the first side. The binder contained in the
outermost layer on the first side and the binder contained in
the outermost layer on the second side have a common monomer
composition to a degree less than 75 wt%. The outermost layer on
the first side contains a polymer latex in an amount of 50 wt% or
more of the total binder contained in the outermost layer on the
first side. Finally, the outermost layer on the second side

contains a polymer latex in an amount of 50 wt% or more of the total binder contained in the outermost layer on the second side.

Disclosure of Melpolder '754

Melpolder '754 discloses thermally processable imaging elements in which the image is formed by image-wise heating or by image-wise exposure to light followed by uniform heating. The thermally processable imaging elements are comprised of a support, a thermographic or photothermographic imaging layer, a protective overcoat layer which is an outermost layer on the same side of the support as the imaging layer, a backing layer which is an outermost layer on the side of the support opposite to the imaging layer, and an electroconductive agent in at least one layer of the element. Each of the protective overcoat layer and the backing layer contains a fluorosurfactant in an amount sufficient to serve as a triboelectric charge control agent.

Disclosure of Defieuw '467

Defieuw '467 discloses a photothermographic recording material with a thermosensitive element on one side of a water resistant support and an outermost backside layer on the other side of the water resistant support. The thermosensitive element comprises a substantially light-insensitive organic silver salt

and a binder and the outermost backside layer comprises polymeric beads.

Removal of the Rejection over Melpolder '754 in view of Defieuw '467

Melpolder '754 does not disclose a polymer latex in the outermost layer on the first side, but, instead, uses a polyvinyl alcohol. Mr. Kubo, the inventor of the instant application, has submitted a 37 CFR §1.132 declaration attached to this reply in which Mr. Kubo reports the results of comparative experiments. In particular, Mr. Kubo prepared seven thermally processed image forming materials having the imaging layer and the protective overcoat layer disclosed in Melpolder '754. The results in the declaration indicate unexpectedly superior properties of the instant invention. Please see the 37 CFR §1.132 declaration. In particular, the material of the Melpolder '754 reference showed adhesion, which defeats the stated objective of the instant invention.

The Applicant also submits that one of ordinary skill in the art when reading Melpolder '754 would not be motivated to use a polymer latex in an amount of 50 wt% or more of the total binder in the outermost layers in both sides as there is no suggestion or disclosure in either of the references of using the polymer latex

Appl. No.: 09/640,803
in these amounts. Accordingly, Applicant submits that the rejection over Melpolder '754 in view of Defieuw '46 is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks and amendments, it is believed that the claims, as they now stand, define patentable subject matter such that a passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee of \$920.00 is attached hereto.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

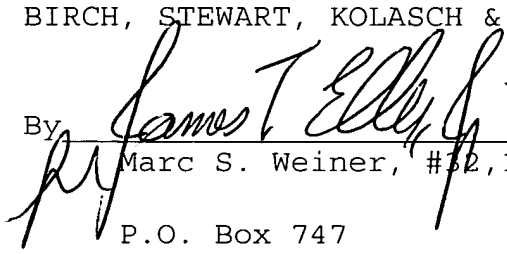
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any

additional fees required under 37 C.F.R. §§ 1.16 or 1.17;
particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

 #39,538

Marc S. Weiner, #2,181

MSW/TBS/jmb

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Enclosure: 37 CFR §1.132 Declaration

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims have been amended as follows.

Claim 1 (Amended) A thermally processed image forming material having a first side and a second side wherein

the first side has an image forming layer and a first outermost layer containing a binder and the second side has a second outermost layer containing a binder which is different from the binder of the first outermost layer on the first side, [on only one side of a support an image forming layer characterized in that the outermost layer on the same side with the image forming layer contains a binder different from that contained in the outermost layer on the opposite side of the support]

the binder contained in the first outermost layer on the first side and the binder contained in the second outermost layer on the second side have a common monomer composition to a degree less than 75 wt%, and

the first outermost layer on the first side contains a polymer latex in an amount of 50 wt% or more of the total binder contained in the first outermost layer on the first side and the second outermost layer on the second side contains a polymer latex

Appl. No.: 09/640,803

in an amount of 50 wt% or more of the total binder contained in
the second outermost layer on the second side.

Claims 11-13 have been added.